

REMARKS

Applicants have received the Decision of Appeal of December 23, 2011, in which the Board affirmed the following Examiner's rejections, but designated its decision as new grounds of rejection thereby permitting Applicants to file this amendment to reopen prosecution. Applicants hereby amend claims 1, 17, 22, and 23. Based on the amendments and arguments contained herein, Applicants believe this case to be in condition for allowance.

The Board interpreted the claims in a much broader sense than the Examiner interpreted the claims. With reference to the claims, the Board held that "what the data are deemed to represent is not entitled to weight in the patentability analysis." Decision page 3. The Board based its claim construction analysis on the information being obtained and the results being computed allegedly being "non-functional descriptive material" rather than functional descriptive material. As a result, the Board viewed claim 1, for example, as simply requiring obtaining some information and calculating a number by dividing to other numbers—a process which is not patentable.

Applicants hereby address the Board's concerns by making various amendments to the claims to ensure a construction of the claims that the data is indeed "functional descriptive material" thereby being entitled to patentable weight. With respect to claim 1, Applicants have added the limitation of "loading a sufficient quantity of media into a backup device or media pool to result in the projected number of media being loaded." Claim 1 requires determining a projected number of media for a future execution of at least one backup job and then loading enough media into a backup device or media pool to result in the calculated projected number of media being loaded. As such, there is a functional relationship between what data being calculated and displayed and a quantity of media to being loaded. The projected number of media being calculated represents data that is functional descriptive material and thus entitled to weight in the patentability analysis.

Similarly prompted amendments have been made to claims 17 and 23. In claim 17, a backup system is now required to be loaded with a sufficient quantity of media “to result in at least the target number of media being loaded. Claim 23 requires that the media loaded so as to result in the proposed number of media being loaded is verified. Such amendments render the “target number of media” (claim 17) and the “proposed number of media” (claim 23) to be functional descriptive material.

In a footnote in the Decision, the Board also suggested that the Examiner should consider whether the claims are directed to patent eligible subject matter under 35 U.S.C. § 101. See footnote 1 page 4 of the Decision. Applicants amend claim 1 to require the actions of obtaining and calculating to be performed by a processor, and the projected number of media is displayed. These actions, coupled with the limitation of loading the media, ensure the claim complies with the statutory subject matter requirement of 35 U.S.C. § 101. For example, displaying the projected number of media and loading the media into a backup device are not actions that can be performed by the human mind.

The Board did not address the Examiner’s prior analysis of the prior art to the claims. In their appeal briefs, Applicants explained that the claims were patentable over the cited art. Applicants provide only a summary here of those arguments and invite the Examiner to review their appeal and reply briefs in full.

Claim 1 requires “obtaining, by a processor, information regarding a future backup from one or more backup applications for a plurality of backup jobs; calculating, by the processor, a projected number of media for a future execution of at least one of the backup jobs using the information regarding the future backup.” Bolin does not at all teach or even suggest obtaining “information regarding a future backup from one or more backup applications.” Bolin teaches mount and unmount commands. If the mount or unmount command received by the library 16 is equated to the claimed “information regarding a future backup,” then Bolin and Kanai (relied only for the specific calculation) fail to teach

“calculating...a projected number...using the information regarding the future backup” as Bolin’s library 16 does not calculate a number of media. Conversely, if Bolin’s migration and backup application is relied upon for “obtaining information regarding a future backup from one or more backup applications,” then Bolin and Kanai fail to teach “calculating...a projected number...using the information regarding the future backup.” as, according to the Examiner previously, “all cartridges...are intended to be written to” and therefore there is no need to perform such a calculation.

For at least this reason, claim 1 and its dependent claims are in condition for allowance. The same or similar reasoning applies as well to the other independent claims and their dependent claims.

Claim 23 is allowable for an additional reason. Claim 23 requires that the media specified by the user to be loaded so as to result in the proposed number of media being loaded are verified. Applicants’ disclosure provides various examples of media verification. One such example is based on the “protection date has expired for a previously written data media.” See published application para. 36. None of the art of record teaches media verification.

Finally, if the Examiner maintains the previous double patenting rejection, Applicants request the rejection to be held in abeyance pending resolution of all other issues.

CONCLUDING COMMENTS

Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. It is believed a Request for Continued Examination (RCE) is not needed in this case and that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees

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required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,

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